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Buildings As Trademarks

by Gary N. Hardiman

Having just registered a building design as a federal trademark, it occurs to me that architects whose designs are employed in corporate image-building and marketing programs should be made aware of the advantages of trademarks to their clients—advantages that will enhance the value of the architect's services. Put another way, you could make more money by interesting your client in using a building as a trademark and by coming up with a trademarkable design.

To understand why requires some knowledge of the general protections "intellectual property" law affords an architect's work product and the specific niche occupied by trademarks. Trademarks, copyrights, and patents exist under the general umbrella

of intellectual property law. Standard AIA documents reserve to the architect a copyright in the documents produced for a client. It now is fairly straightforward that an original design of a building—embodied in architectural plans or an actual building—is subject to copyright protection under the Copyright Act.

By a different route, a distinctive building design, or a distinctive part of a building design, may be entitled to protection as a trademark as well. A trademark is a symbol—Coca-Cola soft drinks, Ivory soap, Exxon gasoline—that identifies and distinguishes a product and designates a source for goods or services (in which case it is called a service mark). It need not be a word. Federal trademark applications have skyrocketed since the passage of new laws in 1988 that

permitted applications to register marks not yet in actual use. More than 127,000 applications were filed in 1991 alone. Keeping in mind that most educated people have a command of some 20,000 words, you can see how unique building designs could stand out from the crowd as strong identifying symbols.

Architects with clients who operate retail chains or franchises probably are familiar with the desires of companies for distinctive building designs to facilitate a regional or national uniform appearance and marketing approach. The original McDonald's "golden arches" restaurant design, Howard Johnson's restaurant design, and the Potomac drive-up kiosk design are all registered marks. Additionally, single-location building designs, like the City of Anaheim's stylized "A" structure located in front of its convention center, the Transamerica pyramid, and the Temple of Eck church in Minnesota also have been registered.

The process

The B141 commentary advises that issues like the trademark potential of a building be broached with your client as early in the planning stages as possible, and you probably will want a competent attorney with trademark experience involved early on. The trademark generally will be the property of the building's owner or user, not of the architect. But it is the architect's ability to create or render the trademark potential in a distinctive design that lays the groundwork for the client's ultimate right to the mark. You ought

to be compensated for this, particularly where the client has in mind a campaign to exploit the image.

For a building design to qualify for federal trademark registration, it must be used as a mark to identify and distinguish the applicant's goods or services in commerce. To demonstrate such use, "specimens" of the design's use in the promotion of goods and services, like menus, letterheads, and newspapers ads, are filed with the application. Keep in mind that design elements that are primarily functional are not as protectable by trademarks. Similarly, functionally required design elements, like bare "facts" in literature, are not protected by a copyright; the intellectual creation is.

However, if a design feature is only incidentally functional and serves primarily as a source-designating symbol, it can qualify for protection. An example: Howard Johnson's orange cupola is functional because it keeps out the rain, but its main purpose is to function as a trademark and beckon the traveler with its siren song of familiarity. It has been held protectable by the courts, and an injunc-

tion has been issued against a copycat competitor.

Even a not-yet-existing building has trademark registration potential. Under a recent "intent to use" statute, trademark registration can be applied for before actual use and then perfected when the mark is put into actual use—a possible advantage in a registration process that often takes a year or more. Similarly, it allows for midcourse adjustments if the client's application encounters obstacles during the approval process.

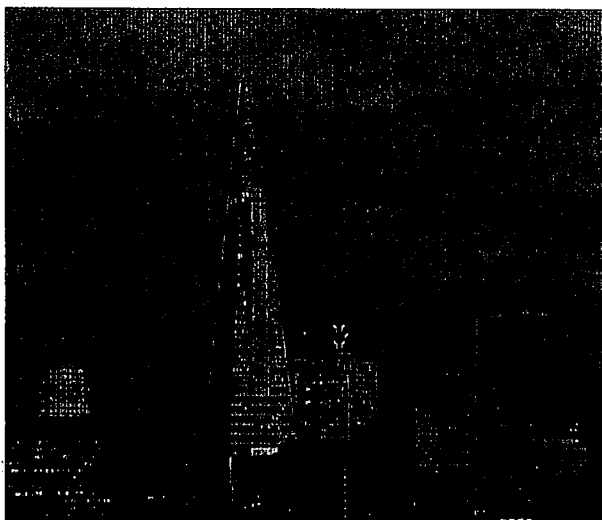
The next time a client likes your design so much he or she envisions a marketing campaign based on it, don't just enjoy the admiration—talk about the issues involved. Explore the identifying value of the design and negotiate for added compensation.

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Advantages of Registration

It is not necessary to federally register a mark to acquire some trademark rights in a building design, as long as the design is used as a mark. Registration, however, is relatively inexpensive and provides several benefits, including:

- A presumption of exclusive nationwide rights to the mark
- The right to sue infringers in federal court for profits, damages, and costs as well as treble damages and attorney's fees in some cases
- The registration is evidence of the validity of the mark and the owner's exclusive ownership rights
- Registration places the mark on public record and provides constructive notice to others of the existence of the registration
- The owner may deposit the registration certificate with Customs to stop the importation of infringing products
- Registration makes obtaining registration in foreign countries easier
- Registration makes licensing and franchising simpler and more legally secure.



The iconic Transamerica pyramid is a registered trademark.